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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/529,212 | 03/25/2005 | Herve Cunin | 032326-294 | 8825 |
| 21839 7590 11/17/2009 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404 | | | | |
| EXAMINER | | | | |
| KOYAMA, KUMIKO C | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2887 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 11/17/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/529,212

Applicant(s)

CUNIN ET AL.

Examiner

KUMIKO C. KOYAMA

Art Unit

2887

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 0709

DETAILED ACTION

Amendment received on July 06, 2009 has been acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 26-31 and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Yap et al (US Patent Application Publication No. 2003/0066893 A1).

Re claims 26 and 31: Yap discloses a reader 4401 that is configured for the reading of the card 10. The reader 4401 is formed of a housing 4402 incorporating a card receptacle 4404 that includes an access opening 4410 through which a smart card 10 is insertable (Paragraph [0144]). Fig. 46 and Fig. 47(c) shows a structure defining a function position for communicating with the smart device when the smart device is located at the function position. Yap discloses contacts 4407 extend from a connector block mounted upon a printed circuit board positioned between the base section and support surface by way of the two mountings. Arranged on an opposite side of the PCB to the connector block is electronic circuitry, electrically connected to the connectors 4407 and the touch sensitive membrane and configured for reading data from the card 10 (Paragraph [0150], lines 1-10). Yap discloses that the exposed contacts and associated circuitry

of the reader are configured to read the stored data associated with the control indicia from the memory chip, either automatically upon insertion of the smart card into the control template receptacle, or selectively in response to a signal from the remote reader. This signal can, for example, be transmitted to the smart card via the exposed contacts and data contacts (Paragraph [0085]). Yap discloses that the card comprises a memory for storing distinguishing identifier and a service identifier for identifying a service to be received via an external device 100 (Abstract). Such connectors 4407 are first connecting means for connecting with the smart device when the smart device is located at the functional position, so as to receive data from the terminal device. Yap discloses Infra-red (IR) communications that are implemented using two circuits connected to the microcontroller 44, an IR transmitter 49 for IR transmission and an IR receiver 40 for IR reception (Paragraph [0155]). Such disclosure teaches second connecting means for transmitting the received data to the terminal device. Yap discloses a viewing area 4406 that preferably has the same dimensions as the upper face 16 of the card 10 such that the upper face 16 is, for all intents and purposes, fully visible within the viewing area 4406 through the transparent pressure sensitive membrane 4408 (Paragraph [0146], lines 8-12). Such disclosure teaches a transparent portion for allowing at least a portion of the smart device to be visible therethrough when the smart device located at the functional position and connected to the first connecting means.

Re claim 27: As shown in Fig. 10, Yap shows the microcontroller 44 interfaces between the smart device at component 42 and the terminal device via the receiver 40/transmitter 49, and the input connector in the smart card I/F 42 and the microcontroller 44 forms a component set as reader 1.

Re claim 28: As shown in Fig. 43 and Fig. 45, Yap shows a pair of longitudinal slides 4404.

Re claims 29 and 30: As shown in Fig. 47 (a), Yap shows a pair of arms near reference number 4811 that connects the pair of longitudinal slides to the component set and forming a V shape.

Re claims 38-40: Yap discloses a reader 4401 that is configured for the reading of the card 10. The reader 4401 is formed of a housing 4402 incorporating a card receptacle 4404 that includes an access opening 4410 through which a smart card 10 is insertable (Paragraph [0144]). Fig. 46 and Fig. 47(c) shows a structure defining a function position for communicating with the smart device when the smart device is located at the function position. Yap discloses contacts 4407 extend from a connector block mounted upon a printed circuit board positioned between the base section and support surface by way of the two mountings. Arranged on an opposite side of the PCB to the connector block is electronic circuitry, electrically connected to the connectors 4407 and the touch sensitive membrane and configured for reading data from the card 10 (Paragraph [0150], lines 1-10). Yap discloses that the exposed contacts and associated circuitry of the reader are configured to read the stored data associated with the control indicia from the memory chip, either automatically upon insertion of the smart card into the control template receptacle, or selectively in response to a signal from the remote reader. This signal can, for example, be transmitted to the smart card via the exposed contacts and data contacts (Paragraph [0085]). Yap discloses Infra-red (IR) communications that are implemented using two circuits connected to the microcontroller 44, an IR transmitter 49 for IR transmission and an IR receiver 40 for IR reception (Paragraph [0155]). Such disclosure teaches a functional position for

receiving the chip card so as to establish a two way communication link between the chip card and the external terminal device. Yap discloses a viewing area 4406 that preferably has the same dimensions as the upper face 16 of the card 10 such that the upper face 16 is, for all intents and purposes, fully visible within the viewing area 4406 through the transparent pressure sensitive membrane 4408 (Paragraph [0146], lines 8-12). Such disclosure teaches a part at least partially covering the functional position, wherein the part comprises a transparent or translucent material.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32-37, 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yap in view of Graczynski et al (US 4,492,855).

Re claims 32, 37 and 41-47: Yap discloses a reader 4401 that is configured for the reading of the card 10. The reader 4401 is formed of a housing 4402 incorporating a card receptacle 4404 that includes an access opening 4410 through which a smart card 10 is insertable (Paragraph [0144]). Fig. 46 and Fig. 47(c) shows a structure defining a function position for communicating with the smart device when the smart device is located at the function position. Yap discloses contacts 4407 extend from a connector block mounted upon a printed circuit board positioned between the base section and support surface by way of the two mountings. Arranged on an opposite side of the PCB to the connector block is electronic circuitry, electrically

connected to the connectors 4407 and the touch sensitive membrane and configured for reading data from the card 10 (Paragraph [0150], lines 1-10). Such connectors 4407 are input connecting means for connecting with the smart device when the smart device is located at the functional position, so as to receive data from the smart device. Yap discloses Infra-red (IR) communications that are implemented using two circuits connected to the microcontroller 44, an IR transmitter 49 for IR transmission and an IR receiver 40 for IR reception (Paragraph [0155]). Such disclosure teaches an output connecting means for transmitting the received data to the terminal device. Yap discloses a viewing area 4406 that preferably has the same dimensions as the upper face 16 of the card 10 such that the upper face 16 is, for all intents and purposes, fully visible within the viewing area 4406 through the transparent pressure sensitive membrane 4408 (Paragraph [0146], lines 8-12). As shown in Fig. 47 (a)-(c), the bottom face of the card is also visible as there is an opening 4410. Such disclosures teaches a transparent portion for allowing at least apportion of the opposed top face of the card and at least a portion of the opposed bottom face of the card to be visible therethrough when the card is located at the functional position and connected to the input connector.

Yap fails to teach that the transparent or translucent portion allows at least a portion of the opposed bottom face of the card to be visible.

Graczynski discloses that a clear light transparent plastic film 51 is placed over the top edges of the housing 40 and a comparable light transparent film 52 is placed over the lower surface of housing 40, thereby providing a chamber defined by the two films and housing 40 (col 3, line 66-col 4, line 3).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Graczynski to the teachings of Yap such that both sides of the card can be visible to ensure that secure and proper connection is made between the card and the card reader, which ensures that proper data transmission can be made.

Re claim 33: As shown in Fig. 10, Yap shows the microcontroller 44 interfaces between the smart device at component 42 and the terminal device via the receiver 40/transmitter 49, and the input connector in the smart card I/F 42 and the microcontroller 44 forms a component set as reader 1.

Re claim 34: As shown in Fig. 43 and Fig. 45, Yap shows a pair of longitudinal slides 4404.

Re claims 35 and 36: As shown in Fig. 47 (a), Yap shows a pair of arms near reference number 4811 that connects the pair of longitudinal slides to the component set and forming a V shape.

Response to Arguments

5. Applicant's arguments with respect to claims 26-47 have been considered but are moot in view of the new ground(s) of rejection.

Applicant amended the claims with new limitation, such as "structure defining," "receive," etc. Such newly amended claims necessitated new grounds of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUMIKO C. KOYAMA whose telephone number is (571)272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kumiko C. Koyama/
Primary Examiner, Art Unit 2887
November 08, 2009